

## REMARKS

As requested by the Examiner, Applicant's have resubmitted the prior response filed on 10/04/2004, which provides the listing of the claims along with the claim identifiers and the original response.

In the previous Election, the applicants elected the species of claim 26, but did not cancel claims directed to the unelected species. In addition, no claims have been withdrawn. Accordingly, claims 1-174 are in the application.

Claims 1, 24, 25, 28, 30, 32, 33, 37, 39, 41, 44, 52, 54-56, 63, 64, 67, and 70 have been amended to rectify various informalities with respect to antecedent basis. These informalities were manifest and the amendments were not made to evade prior art or in response to any rejection, objection or request by the examiner. Accordingly, these amendments do not reduce the scope of equivalents to which the claims are entitled.

In addition, claims 1, 24 and 25 have been amended to recite a playlist generation device for generating a playlist response including a playlist identifying "a plurality of selected ads to be fetched and presented" by a client device. The addition of "fetched" to these claims is supported in the originally-filed specification at page 36, line 22. In claim 25, the playlist request is received "from the client device" according to the specification at page 57, line 8.

In the previous Election, the applicant elected the species of claims 1 and 24-73, but did not cancel claims directed to the unelected species. In addition, no claims have been withdrawn. Accordingly, original claims 1-174 are in the application.

Claims 1 and 24-73 are provisionally rejected for obviousness-type double patenting over various claims of US Patent Application No. 09/679,039, US Patent Application No. 09/679,038, US Patent Application No. 09/728,693, US Patent Application No. 09/668,553, US Patent Application No. 09/668,331, US Patent Application No. 09/668,632, US Patent Application No. 09/668,515, US Patent Application No. 09/668,631, and US Patent Application No. 09/668,600. In view of the fact that prosecution is still ongoing in those applications, the applicants reserve response to this provisional rejection until all other issues of patentability are settled in all of these applications.

### **Anticipation**

Claims 1, 24-39, 51, 52, and 66-69 are rejected for anticipation by US Patent 5,848,397 ("Marsh"). That rejection is traversed for the following reasons.

The claimed playlist server system supplies a playlist response to a client device that also exchanges information with an information server system. The playlist response includes a playlist “identifying a plurality of selected ads to be fetched and presented” by a client device. The playlist is generated by a device in the playlist server system and transmitted to the client device. The information server system and the playlist server system are independently controlled.

The “playlist” recited in claims 1 and 24 is defined in the specification, for example, at page 36, line 20 through page 37, line 8. According to the definition, the playlist is a list of identifications of advertisements to be fetched by the client device. In this regard, the playlist does not contain advertisements, only various addresses whence they may be fetched.

The role of the playlist may be understood with reference to FIG. 14 of the application. As illustrated, a client device “pulls” advertisements to itself by means of the “playlist” in its possession “identifying a plurality of selected ads to be fetched”. With the playlist in hand, the client device fetches advertisements identified in the playlist. As described in the specification at page 37, lines 18-23, the client software “begins fetching ads not resident in the e-mail client’s ad cache from one or more ad servers.” The advertisements fetched by the client device are stored and displayed at the client device.

In contrast, Marsh’s message scheduling apparatus “pushes” advertisements to a client system, with a server system selecting the advertisements to be displayed on the client system and sending them to the client system. This process is fully set forth in Marsh at col. 2, lines 12-17 by way of the incorporation by reference of US Patent Application 08/948,779, now US Patent 6,014,502 (“Moraes”). As Moraes discloses in FIGS. 9 and 11, and at col. 20, lines 40-50, a server system determines which advertisements are to be downloaded to (not by) a user, and when. Then “new banner and showcase advertisements are transmitted” to the user from an e-mail server M<sub>n</sub> when “the user connects to mail server M<sub>n</sub>”. See Moraes at col. 21, lines 3-6. In other words, the decision to download advertisements is made and carried out by an e-mail server function only when the client device connects to the mail server for e-mail service. The client device does not fetch advertisements. Neither Marsh nor Moraes discloses a playlist response including a “playlist” or any other equivalent structure that identifies advertisements to be fetched and presented by a client device which is transmitted to the client device. Without a playlist “identifying a plurality of selected ads to be fetched”, Marsh necessarily has neither a

“playlist response generation function” nor a link “over which the playlist response is transmitted to the client device”.

Claims 1, 24-39, 51, 52, and 66-69

Nevertheless, with respect to claims 1, 24-39, 51, 52, and 66-69, the contention in the Office Action is that “Marsh teaches a playlist server system for supplying a playlist response to a client device exchanging information with an information server system over a communications network (abstract)”. In fact, Marsh’s Abstract discloses a user receiving advertisements from a server system and making statistical information available to a server system. A “playlist server system” is defined and enabled at page 55, line 6 through page 61, line 22 of the specification. Marsh’s Abstract does not enable a “playlist server system”, nor does it describe one. The advertisements provided by the server system are not a “playlist” or a list of any kind; they are not described as a reply or reaction and are not otherwise characterized as a “response”. The statistical information cannot be characterized as a playlist response because it is made available by a user, not by a server. Marsh therefore omits “a playlist server system for supplying a playlist response to a client device”.

The further contention is that Marsh teaches a “playlist response generating means” in Figure 8 and at column 15, lines 1-10. Figure 8 shows information communicated between a server system 104 and a client computer 101. The server system 104 is an undifferentiated block with no devices shown. The description of Figure 8 discloses a server system 104 with an advertisement distribution scheduler that assigns advertisements to users. Marsh discloses that this server scheduler produces a list of users for each advertisement, but does not disclose that it produces a list identifying ads to be fetched and presented by a user. The server system 104 also includes an advertisement download scheduler that downloads the assigned ads to users. However the downloaded advertisements themselves do not form a list that identifies ads to be fetched and presented by the users. An advertisement is an entity unto itself; it is not an identification of itself. The advertisements are downloaded to users by the advertisement download scheduler; they are not “fetched” by the users. None of the information exchanged between the server system 104 and the client computer 101 in Figure 8 is described or characterized as “a playlist”; none of the exchanged information identifies “a plurality of selected ads to be fetched and presented by” the client computer 101. At column 15, lines 1-10, Marsh describes a statistics log file kept by an advertisement display scheduler 700 of the client system

101. According to Marsh's Figure 8, this file is transmitted by the client computer 101 to the server system 104. Therefore, whatever the statistics log file is, it is manifestly not a "playlist response" or a response of any kind that is transmitted *to* a client device *by* a server. Consequently, Marsh omits "a playlist response generation device for generating a playlist response including a playlist identifying a plurality of selected ads to be fetched and presented by the client device; and a first communications device that effects a playlist response send communications link with the client device via the communications network over which the playlist response is transmitted to the client device".

Finally, as recited in claims 1 and 24, "the information server system and the playlist server system are independently controlled". The rejected claims recite two server systems: the playlist server system for supplying a playlist response to a client device and the information server system which exchanges information with the client device. These are separate entities in the claim and in the specification; neither server system is bound by or committed to the other in any aspect of its operation; that is to say, they are "independently controlled". Marsh, at column 13, line 56 through column 14, line 63 only teaches that the display of advertisements at the client computer 101 is controlled independently of the server system 104. However, the client computer 101 is not a server system. The cited passage and the figure describe and illustrate only a single server system that provides advertisements to and exchanges information with the client computer 101. Consequently, Marsh omits any teaching that "the information server system and the playlist server system are independently controlled".

As to claims 25 and 26, Marsh's description omits a "playlist request". The statistics log file is used by an advertisement display scheduler in the client system to display ads; it is evidently sent by the client device to the server system where it may be "used by the advertisement distribution scheduler and the advertisement download scheduler". However, in sending the statistics log file, the client device is not asking for or requesting anything from the server system and the server does not respond to receipt of the statistics log file by "generating a playlist". Marsh also omits description of any parsing device in the server system 104 that extracts "selected information" from "requests" sent by the client computer 101. Finally, Marsh does not disclose any device in the server system 104 that supplies "selected information" extracted from a client computer request to a "playlist generation device".

As to claim 27, Marsh omits a server system device that supplies information identifying the client system as either a hardware or software client device.

As to claim 28 Marsh at column 15, lines 2-13 describes a statistics log file maintained by a client system 101 and made available to a server system 104. The statistics log file is used by an advertisement display scheduler in the client system to display ads; it is evidently sent by the client device to the server system where it may be “used by the advertisement distribution scheduler and the advertisement download scheduler”. However, in sending the statistics log file, the client device is not asking for or requesting anything from the server system. Further, Marsh does not teach that the server system 101 responds to transmission of the statistics log file in any way, in particular, by indicating validity or transmitting a playlist, or a list of any kind.

As to claims 29-39 and 66-99, the contention is that Marsh teaches “a cookie containing information describing user/client behavior” that is transmitted to a playlist server in order to provide a new playlist associated with the client device. A “cookie” is a file of information sent from a user to a server every time the user requests something from the server. The server uses the information in the cookie to customize a response to the user request. No “cookie” is described in Marsh. At col. 14, line 16 through col. 15, line 20, and in Figure 8, Marsh describes advertisement archives transferred to the client computer 101 by the server system 104. These archives are not “cookies”. This passage also describes a priority queue maintained by the advertisement display scheduler 700 in the client computer 101. This queue is not a “cookie”. The passage also sets forth a statistics log file that the advertisement display scheduler 700 maintains for advertisement display scheduling. The file may be “used by the server system 104 for billing and reporting purposes.” But there is no teaching that the statistics log file has any characteristics of a “request” or that it accompanies a request from the client computer 101 to the server system 104. Nor is there any disclosure in Marsh that the statistics log file is used by the server system 104 to customize a response to any information transmitted to it by the client computer 101. Marsh nowhere describes a playlist request parsing device in a playlist server that employs a document type definition (DTD).

Accordingly, Marsh’s description of scheduling message presentation omits one or more elements and/or limitations of claims 1, 24-39, 51, 52, and 66-69 and does not anticipate those claims.

### **Obviousness**

Claims 40-49, 53-65, and 70-73 are rejected for obviousness over Marsh. That rejection is respectfully traversed because Marsh omits elements and/or limitations of claims from which these claims depend, for reasons given above, and also for the following reasons.

With respect to claims 40-45, the selected information that is specified in detail is used “to thereby initiate the playlist generation device”. No such motivation is suggested by Marsh or any reference of record. Marsh’s advertisement display scheduler 700 responds to predetermined scheduling criteria, which are used only to establish priority between queued advertisements (that are not yet displayed). See Marsh at column 3, lines 60-65. Statistics regarding displayed advertisements are kept by the advertisement display scheduler 700 to determine which advertisements to display subsequently. These statistics are used by the server system 104 for billing and reporting. See Marsh at column 15, lines 5-15. Marsh however does not mention a quota of ads that a user is supposed to view or a time period for viewing a set of ads. Marsh therefore neither suggests nor includes the specific selected information.

With respect to claims 46 and 47, Marsh at column 14, lines 10-22 teaches that all “information to output an advertisement” is contained in the archives by which the advertisements are transmitted from the server system 104 to the client computer 101. No output information is transferred from the client computer 101 to the server system 104. Presumably, the client computer 101 has a display function that includes means to automatically format the displayed advertisements. Further, the only user interaction information of interest to Marsh is “events”, that is to say occasions when a user clicks on an ad. Such events can be logged without knowing the dimensions of the client computer display. Consequently, there is no suggestion or motivation in Marsh to report client device screen dimensions to a playlist server.

With respect to claims 48-50 and 62-64, Marsh teaches logging advertisement display statistics and events at column 14, line 66 through column 15, line 20. As pointed out in the Office Action these comprise “client information”. The contention in the Office Action is that because it is known to provide identity information in order to point out individuality between objects, it would be obvious to include a distributor identifier. The applicants respectfully disagree. As the specification points out in the table on page 43, a distributor identifier (ID) “is used for the bounty system, so that the PlayList Server can identify and credit” the identified distributor with a portion of ad revenue. This is necessary, because of the decentralized nature of

the system described and claimed in this application. With the responsibility for fetching advertisements relegated to the client devices, there is a need to know which distributor is responsible for enabling the downloading of any particular set of ads identified in a playlist. Otherwise, any third party distributor of client devices can claim credit for any and all downloaded ads. However, in Marsh, the system is centralized. The client computer 101 is enabled for advertisement display by the server system 104. The server system 104 is the sole distributor and all advertisements displayed by the client computer are assigned and downloaded by the server system. Accordingly, there is no need, suggestion, or motivation to provide “a distributor ID” to the server system 104, because such an ID would only identify itself.

With respect to claims 53-56, Marsh does not teach a playlist, a playlist request, or a device in a playlist server for parsing selected information from a playlist request. Further, the information logged and transmitted to the server system 104 by the client device 101 does not suggest or include any of the instances of “selected information” specifically recited in these claims.

With respect to claims 57-61, Marsh does not teach a playlist or a playlist response. Further, Marsh has only two ad types: banner ads and showcase ads. A diligent reading of Marsh has failed to produce any explicit indication of how the client computer distinguishes between these types. It is presumed that, in fact, the client computer 101 simply doesn’t need to distinguish between banner and showcase ads because all information necessary to time and place the display of either type is fully conveyed in the priority and output information contained in the ad archives sent to the client computer 101. Accordingly, there is no need, suggestion, or motivation in Marsh for “identifying ad type for one of the respective ads”.

Claims 65 and 70-73 depend from claim 26 and are distinguishable from Marsh for reasons set forth above and for the further reason that Marsh does not suggest or teach the use of any particular language construct for a playlist request. Further to claims 71-73, Marsh discloses a database management system (DBMS) 106 but limits its use to storing an ad contract, member profile data, and demographic data. The advertisement distribution scheduler in the server system 104 runs “database selects” to produce lists of users for advertisements. However, there is no teaching in Marsh that the DBMS 106 builds a query from an object that originates in a “playlist request” received by the advertisement distribution scheduler from a client device.

Accordingly, the rejection of claims 40-49, 53-65, and 70-73 fails to satisfy the both the motivation and “all elements” requirements of *prima facie* obviousness and should be withdrawn.

Therefore, in view of these remarks, it is submitted that the claims of this application are patentably distinguishable from Marsh and all references of record in this application, early notice of which is earnestly requested.

No claim has been amended or canceled.



## CONCLUSION

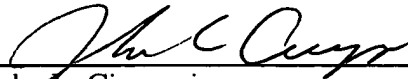
In light of the amendments contained herein, Applicants submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

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